

REMARKS

Summary of the Office Action

Claims 1-2 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,371,350 to *Gonnett et al.* (“*Gonnett*”) in view of U.S. Patent No. 3,091,795 to *Budwig*.

Summary of the Response to the Office Action

Applicants amend claim 1. Support for the amendment may be found at least the ¶[0024] of the specification. Claims 3-12 are withdrawn. Accordingly, claims 1 and 2 are presently pending.

The Rejection Under 35 U.S.C. § 102

Claims 1-2 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Gonnett* in view of *Budwig*. Applicants respectfully traverse the rejections for at least the following reasons.

Applicants respectfully submit that the Office Action has not established that *Gonnett* in view of *Budwig* teaches or suggests each and every feature of Applicants’ claimed invention and that all rejections under 35 U.S.C. § 103(a) should be withdrawn. Independent claim 1 recites, in part, “a rising portion rising from the base portion, the rising portion including a guide face inclined on an inner wall face of the rising portion; and an engaging portion protruding from an inner side of the inclined guide face, the engaging portion which temporarily engages with a leading end of a nailing machine.” *Gonnett* in view of *Budwig* fails to teach or suggest at least these features of claim 1.

In the present invention, a leading end of a nailing machine is engaged with the engaging portion of the part clamp while the leading end is guided by the inclined guide face. Thus, even when the leading end of the nailing machine is roughly inserted to the part clamp, the part clamp can be securely attached to the nailing machine. Applicants respectfully submit that *Gonnet* in view of *Budwig* fails to teach or suggest this feature of the present invention.

The Office Action admits that part 12 of *Gonnet* lacks the inclined guide face and engaging portion recited in independent claim 1. However, the Office Action now asserts that *Budwig* teaches these missing features (an inclined guide face and engaging portion). Applicants respectfully submit that the Office Action has not established a *prima facie* case of obviousness at least because there is no suggestion or motivation to combine *Gonnet* and *Budwig*. To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings. See M.P.E.P. §§ 2142-2143.

While the Office Action acknowledges that *Gonnet* does not teach “the rising portion including a guide face inclined on an inner wall face of the rising portion; and an engaging portion protruding from an inner side of the inclined guide face, the engaging portion which temporarily engages with a leading end of a nailing machine,” as claimed, the Office Action alleges that it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the part clamp 20 of *Gonnet* with items 4 (alleged inclined guide wall) and 9 (alleged engaging portion) of part 1 (one-half of a grommet) of *Budwig* in order to

more effectively secure a tubular nail gun to a part clamp part. See the Office Action on page 3, section 4. Applicants respectfully disagree.

As pointed out in MPEP § 2145(X)(D)(2), it is improper to combine references where the references teach away from their combination. *Gonnet* teaches part clamp 20. By contrast, *Budwig* teaches a half grommet (1) that includes an arcuate recess (4) and a rib (9). See Fig. 1 of *Budwig*. The half grommet in *Budwig* is supposed to engage another half grommet to form a locked grommet opening so materials may pass through. The combination destroys the part clamp in *Gonnet* which does not want to lock a nail gun to itself. Thus, *Gonnet* teaches away from its combination with *Budwig*. Moreover, one of ordinary skill in the art to which the invention pertains would not have been motivated to combine *Gonnet* and *Budwig*.

As such, the suggestion or motivation to combine is not provided by either the references themselves or by knowledge generally available to one of ordinary skill in the art. Thus, the rejection of claim 1 should be withdrawn. Furthermore, claim 2 depends from independent claim 1. Accordingly, claim 2 is also allowable because of the additional features it recites and the reasons stated above.

“The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).” See MPEP § 2143.01. The Office Action does not provide any citation to the references of record that shows the desirability of combining *Gonnet* with *Budwig*. Further, as discussed above, the combination of references necessarily includes features that teach away from the present invention. The mere assertion that

Gonnet and *Budwig* could be combined is not sufficient by itself to establish *prima facie* obviousness. Therefore, it is respectfully submitted that the Office Action has not met *prima facie* obviousness.

Thus, the rejection of claim 1 should be withdrawn. Furthermore, claim 2 depends from independent claim 1. Accordingly, claim 2 is also allowable because of the additional features it recites and the reasons stated above.

CONCLUSION

In view of the foregoing, Applicants respectfully requests entry of the amendments to place the application in clear condition for allowance or, in the alternative, in better form for appeal.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

By: /David E. Connor/
David E. Connor
Reg. No. 59,868

Dated: November 29, 2011

CUSTOMER NO. 009629
MORGAN, LEWIS & BOCKIUS LLP
1111 Pennsylvania Avenue, NW
Washington, D.C. 20004
Tel.: (202) 739-3000
Fax: (202) 739-3001